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10/506,916	09/03/2004	Jens Erik Sommerlund	1175/72960	6999

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Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

FELAU, LISEDA

ART UNIT	PAPER NUMBER
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1791

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04/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,916	Applicant(s) SOMMERLUND ET AL.	
	Examiner LISED A FELAU	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/03/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. This is an initial Office Action based on US application 10/506,916 by JENS SOMMERLUND and CHRISTIAN HANSEN filed on September 3, 2004. Claims 1-16 are currently pending and have been fully considered for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claims 1 and 6, the phrase "for example" understood to mean the same as "eg" in line 1 of claim 1 and line 2 of claim 6, renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, the phrase "per se" in line 20 of claim 1 reads to mean the same as "such as". The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

- Regarding claims 2, 4, 6, 9, 13, and 14 the phrase "preferably" renders the invention as claimed indefinite because it is unclear whether the limitation(s) following

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the phrase are part of the claimed invention. Examiner reads the phrase the same as 'optional' and that limitation(s) following the phrase are not necessarily part of the claimed invention.

- A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4, recites the broad recitation of a face forming an angle α of 20-40°, and the claim also recites preferably 25-35°, which is the narrower statement of the range/limitation. In addition, claim 14, recites that the support surface forms an angle α of 20-40°, and the claim also recites preferably 25-25°, which is the narrower statement of the range/limitation.

- Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 7, 8, 10, 13, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over BINGHAM et al. (US 3,042,975) in view of AUBERRY et al. (US 5,032,330) and AUBERRY et al. (US 3,965,517).

Regarding claim 1, BINGHAM et al. teaches a method for molding soles of rubber material and shoe welts on a shoe upper using a molding apparatus to make shoes having a welt on a molded outer sole (a method for molding soles and shoe welts on shoe uppers by means of a mold so as to provide the finished shoe with a welted appearance) [col.1, lines 10-14; col. 2, lines 20-22]. As shown in Figure 7, the molding apparatus comprises of a last 22 made of metal supporting a shoe upper 10 (said mold including a last, upon which a shoe upper is arranged), a bottom plate 24 mounted for movement up

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and down (a lower mold part being vertically movable in relation to the upper mold between an open and closed mold position) and a ring mold member 26 (an upper mold part) extending around the periphery of the last [col.2, lines 20-25; Figure 7]. Ring member is split diametrically and each part is mounted for movement toward and away from last 22 (the upper mold part divided along a longitudinal middle plane and thus including two halves being laterally movable in relation to a lower mold part between an open and a closed mold position) [col.2, lines 27-29]. BINGHAM does not teach that the soles are molded from plastic material like polyurethane.

A- BINGHAM teaches in Figures 3 and 7 welt 14x having an inner outline substantially corresponding to the outline of the lower side section of the shape of the shoe upper which corresponds to the position of the welt on the finished shoe.

B- BINGHAM teaches that the welt is first adhered to a blank sole, then used with the blank in the mold so the welt with the blank is attached and molded to the shoe upper (welt is placed in the mold in the open position of the mold) [col.1, lines 53-54, 58].

C- BINGHAM teaches the ring member (upper mold part) has an inwardly projecting, overhanging flange 28 at its upper edge (an upper projection on each of the halves extends over the welt) [col.2, lines 25-27; Figure 7].

D- BINGHAM teaches in Figure 7 whereby the projecting flange 28 of the upper mold part 26 supports the welt 14x in such a manner that the portion of the welt is tilted inwards and downwards to bring the inner face of the welt into a sealing engagement with the lower side section of the shoe upper 10. BINGHAM does not teach

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of a support face on the upper face of the lower mold part extending and getting close to the projecting flange in order to support the welt as required in claim 1 D.

E- BINGHAM does not teach that plastic material is supplied to the cavity of the mold to make shoe soles.

AUBERRY et al. (5,032,330) teaches a method for manufacturing footwear by providing a mold with a cavity 28 (cavity of the mold) where plastic material like polyurethane (molding soles of plastic material like polyurethane) is injected into the space in order to form a sole and adhere the welt to the shoe upper held by a last (the shoe sole is molded in a manner known by supplying a plastic material to the cavity of the mold as required in claim 1E) [col.2, lines 26-30; abstract; Figure 3]. AUBERRY (5,032,330) does not teach of a lower mold part comprising a support face on the upper face to support the welt and co-act with a pressure surface on the lower support face of the projection flange of the upper mold part as required in claim 1D.

AUBERRY et al. (3,965,517) teaches in Figure 3 of an apparatus for a method to manufacture footwear using a lower mold member 18 with an upper face supporting one surface of welt 12 while the other face of welt is also supported by the lower face of projection 10 so that the welt touches the shoe upper 3 [Abstract; Figure 3].

At the time of invention, it would have been obvious to one of ordinary skill in the art to use the teachings of plastic material like polyurethane and the lower mold part containing a cavity where the plastic material is injected into the mold to form a sole as taught by AUBERRY et al. (5,032,330) in the method as taught by BINGHAM et al. in order to mold soles of plastic material like polyurethane and shoe welts on shoe uppers, making different types of footwear like shoes or sandals. Plastic materials like

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polyurethane aid in adhering strongly the welt between the shoe upper and the sole, making a more unified footwear that would last longer and survive different weather conditions. Furthermore, at the time of invention it would have been obvious to one of ordinary skill in the art to use the teachings of the lower mold part as taught by AUBERRY (3,965,517) wherein the lower mold part has an upper surface or face which extends and supports the welt on one surface in the teachings of modified BINGHAM such that the other surface of the welt is being supported by the lower face of the projection flange of the upper lower part, in order for the welt to tilt upward and/or downward to bring the inner face of the welt into sealing engagement with the lower side section of the shoe upper when both mold parts are moved toward the last supporting the shoe upper and form a closed position of the mold. The placement of the welt onto the side section of the shoe upper is better controlled when the welt is being supported directly by surfaces of movable upper and the lower mold parts in order to bring the welt to a secure position with side section of the shoe upper so that when plastic material like polyurethane is injected into the mold cavity to form a sole, it does not overflow through the welt and seen on the other side of the shoe.

Regarding claim 2, the teachings as referenced in claim 1 apply. As seen in Figure 7 of BINGHAM, the inner end face of the welt has planar surface.

Regarding claim 3, the teachings as referenced above in claim 1 apply. Also, see Figure 7 of BINGHAM.

Regarding claim 7, BINGHAM teaches that a welt is made of soft flow able rubber (soft material like rubber) [col.1, lines 53-54].

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Regarding claim 8, the teachings as referenced above in claim 1 apply. In Figure 3 of AUBERRY et al. (3,965,517) shows the lower mold part 18 supporting directly on its surface welt 12 which reads on limitations of claim 8.

Regarding claim 10, the teachings as referenced above in claim 1 apply. BINGHAM teaches of a shoe welt and that it is substantially annular [Figure 3]. In Figure 7, the surface of the welt that touches the side portion of the shoe upper is vertical.

Regarding claim 13, the teachings as referenced in claim 1 apply. Modified BINGHAM teaches of a mold for practicing the method as requested in claim 1 and meets the requirements of claim 13.

Regarding claim 15, the teachings as referenced in claim 1 apply. Modified BINGHAM with AUBERRY et al. (3,965,517) teaches where the projection of upper mold 26 of BINGHAM extends beyond the side wall when used with the lower mold part 18 as taught by AUBERRY et al. (3,965,517) in Figure 3.

Regarding claim 16, the teachings as referenced in claim 1 and 15 apply. The inner surface of the projection flange of upper mold is parallel with the supporting surface of the lower mold part.

7. Claims 5, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over BINGHAM et al. (US 3,042,975) in view of AUBERRY et al. (US 5,032,330) and AUBERRY et al. (US 3,965,517), as applied to claims 1-3, 7, 8, 10, and 13, 15-16 above, and in further view of BYRNE et al. (US 1,530,297).

Modified BINGHAM teaches a method for molding soles of rubber material and shoe welts on a shoe upper using a molding apparatus to make shoes having a welt on a molded outer sole as referenced in claim 1.

Regarding claim 5, modified BINGHAM is silent to teaching of an auxiliary supporting sole attached to a welt. BRYNE et al. teaches a method in Figure 3 of an insole (auxiliary sole) attached to an annular welt 5. It would have been obvious to one of ordinary skill in the art to use the teachings of an insole attached to an annular welt in the method as taught by modified BINGHAM in order to support the annular rubber welt onto an auxiliary structure like an insole during the molding method and secure the position of the welt on the molding apparatus thus better adhering the welt with the shoe upper and sole.

Regarding claim 9, the teachings as referenced in claim 1 and 5 apply. BYRNE teaches that welt 5 is attached to insole through means of an adhesive and further secured onto the shoe upper with means of anchor tacks or pins 7 as shown in Figure 5 [col. 2, lines 94-100]. It would have been obvious to adhere the welt onto an insole or auxiliary sole through means of adhesive and/or pins in order to better secure the welt onto the auxiliary sole.

Regarding claim 11, the teachings referenced in claims 5, 9 and 10 apply.

Regarding claim 12, the teachings referenced in claims 1, 5, 9 and 10 apply. The view of the welt 14x as seen in Figure 7 of BINGHAM is interpreted to be a cross sectional view of the welt as it is used in the method. The welt corresponds substantially to a rectangle cross-sectional shape (shoe welt characterized in that its cross-sectional shape corresponds substantially to a rectangle).

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8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over BINGHAM et al. (US 3,042,975) in view of AUBERRY et al. (US 5,032,330) and AUBERRY et al. (US 3,965,517), as applied to claims 1-3, 7, 10, 13-15 above and in further view of OURS et al. (US 4,651,444).

Modified BINGHAM teaches a method for molding soles of rubber material and shoe welts on a shoe upper using a molding apparatus to make shoes having a welt on a molded outer sole as referenced in claim 1.

Regarding claim 6, modified BINGHAM is silent to that the auxiliary sole is made of pervious fabric with a plurality of perforations.

OURS et al. teaches in Figure 4 a sole 4 with perforations 8 [col.4, lines 24-26]. It would have been obvious to one of ordinary skill in the art to use the teachings of OURS regarding a sole with perforations in the teachings of modified BINGHAM where the auxiliary sole attached to the welt has perforations in order to serve as a passages for the plastic at the time of injection thus adhering strongly to the sole and the shoe upper forming a uniform sturdy footwear like boots or sandals. It would have been obvious to one of ordinary skill in the art to modify the diameter of the perforations on the auxiliary sole depending on the density of materials used to make a shoe and the kind of a shoe so that all layers are adhered strongly with the shoe upper and welt.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISEDA FELAU whose telephone number is (571)270-5128. The examiner can normally be reached on Monday thru Thursday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LF

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791

